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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,296	07/12/2001	Motoki Kato	450100-4672.1	2424

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EXAMINER	
PHILIPPE, GIMS S	
ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/904,296	KATO, MOTOKI	
	Examiner	Art Unit	
	Gims S Philippe	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-52 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-52 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is a first office action in response to application no. 09/904,296 filed on July 12, 2001 in which claims 1-52 are presented for examination.

Provisional Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-52 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of the claims of copending application Serial No. 09/904,320.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent(s) granted on those applications since the instant application and each of the referenced copending applications claim common subject matter. Full support for any of claims 1-52 can be found in the referenced application since each specification is identical. Furthermore, claiming of common subject matter is evidenced by the considerable overlap of claims among various ones of the referenced applications. For example comparing claim 1 of the present application with representative claim 1 of copending application (i.e., 09/904296):

Claim 1 of S.N. 09/904,296	**Claim 1 of S.N. 09/904,320**
A decoding apparatus for data of moving pictures for decoding encoded data of moving pictures encoded using a predictive encoding system, comprising:	A decoding apparatus for data of moving pictures for decoding encoded data of moving pictures encoded using a predictive encoding system, comprising:
decoding means for decoding first encoded data made up of moving pictures up to a preset moving picture and second encoded data made up of moving pictures beginning from a moving picture displayed next to the preset moving picture at a speed faster than the display speed of the encoded data; and	decoding means for decoding first encoded data made up of moving pictures up to a preset moving picture and second encoded data made up of moving pictures beginning from a moving picture displayed next to the preset moving picture at a speed faster than the display speed of the encoded data; and
output control means for controlling the outputting of decoded moving pictures based on the time management information of each moving picture of said encoded data.	output control means for controlling the outputting of decoded moving pictures based on the time management information of each moving picture of said encoded data.

4. Conflicts exist between claims of the following related co-pending applications which includes the present application:

37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. All 52 claims of both applications respectively, conflict with each other. The Office has shown that each of these applications contains at least one claim that conflicts with another one of the related co-pending applications identified above, and an analysis 104 claims in the 2 related co-pending applications would be an extreme burden on the Office requiring tens of thousands of claim comparisons.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,396,874. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 1-52 in the present application are included in the claims 1-16 of the cited patent.

Therefore, it is considered obvious that one skilled in the art at the time of the invention having US Patent no. 6,396,874 would have had no difficulty to modify the conditions set in claims 1-16 of the cited patent in order to derive the limitations of claims 1-52 of the present application for the same purpose of decoding moving picture data in which continuity of moving pictures before and after the skipping is maintained to enable skipping reproduction as suggested by Kato.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 6, 11, 14, 17, 23, 28, 35, 41, 47, 50, 3, 8, 12, 15, 18, 21, 22, 25, 27, 30-31, 33-34, 36-37, 39-40, 43-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Toebes, VIII et al. (US Patent no. 5959690).

Regarding claims 1, 5-6, 10-11, 13-14, 16-17, 23, 28, 35, 41, 47, 49-50, and 52, Toebes discloses a decoding apparatus for data of moving pictures for decoding encoded data of moving pictures encoded using a predictive encoding system (See Toebes col. 6, lines 37-48), comprising decoding means for decoding first encoded data made up of moving pictures up to a preset moving picture and second encoded data made up of moving pictures beginning from a moving picture displayed next to the preset moving picture at a speed faster than the display speed of the encoded data (See col. 18, lines 56-67, col. 19, lines 1-24, col. 11, lines 26-38, and col. 24, lines 31-47) ; and output control means for controlling the outputting of decoded moving pictures based on the time management information of each moving picture of the encoded data (See col. 24, line 40-42).

The applicant should note that the user's mouse or joystick is the controlling means, and the user has the choice of displaying the picture at the desired speed. In addition,

the instructions executed by the MPEG player are from the control means (See col. 11, lines 26-32).

As per claims 3, 8, 12, 15, 18, 21, 22, 25, 27, 30-31, 33-34, 36-37, 39-40, 43-44, Toebes, illustrates the claimed decoding steps in a time divisionally manner in figs. 2, 8, and 10, and in col. 8, lines 49-67, col. 9, lines 1-3, col. 15, lines 24-50, col. 20, lines 49-67, and col. 21, lines 1-6).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Oku et al. (US Patent no. 6084637) teaches decoding and displaying device for coded picture data.

Tozaki et al. (US Patent no. 6108281) teaches accessing control for optical recording device capable of performing time search.

Moriyama et al. (US Patent no. 6253018) teaches information record medium, apparatus for recording the same and apparatus for reproducing the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S Philippe whose telephone number is (703) 305-1107. The examiner can normally be reached on M-F (9:30-7:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S Kelley can be reached on (703) 305-4780. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gims S Philippe
Primary Examiner
Art Unit 2613

GSP

December 11, 2004